



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/688,379

10/17/2003

Xiaoli Chen

PRD-0049

3817

27777

7590

12/06/2004

PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

REYES, HECTOR M

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/688,379

**Applicant(s)**

CHEN ET AL.

**Examiner**

Hector M Reyes

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 33-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☒ Claim(s) 1-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### Election/Restrictions

Applicant's election with traverse of group II in the reply filed on 11/10/04 is acknowledged. Group II is drawn to:

- II. Claims 1-32 in part, drawn to **NON HETEROCYCLIC** compounds, pharmaceutical acceptable salts thereof, C<sub>1-6</sub> ester and amide derivatives thereof and pharmaceutical compositions comprising the same, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. *A single disclosed species is hereby requested for search purpose.***

The traversal is on the grounds that the examination of the entire application can be made without serious burden because for example, the heterocyclic and nonheterocyclic ring structures can be included in the same search.

This is not found persuasive at all because the search for both groups does represent a high burden on the Examiner since each group contain particular set of compounds having different classifications and there is not a common substantial core among the said groups. Moreover, each set of compounds embraced by each group has a different structure and reactivity from the others that a reference anticipating one group would not necessarily render the other obvious and to search all the different structurally diverse compounds in a single application would present a serious undue burden to the Examiner. The requirement is still deemed proper and is therefore made FINAL.

### **Status of The Claims**

Claims 1-32 in part, drawn to non-heterocyclic derivatives embraced by claims 1-31 and pharmaceutical compositions comprising the same as described in claim 32 are under Examination. Nonelected subject matter on claims 1-32 and further claims 33-43 are withdrawn from consideration.

### **Claims Objection**

Claims 1-32 are objected because the said claims contain nonelected subject matter. Moreover, Claims 2-31 are also objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claim(s) in independent form. The phrase "A compound of claim 1" does not further limit the compound described in claim 1 because does not included all the limitations of "The compound of claim 1".

### **Double Patenting**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Art Unit: 1625

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-32 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-32 of copending Application No. 10688572. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 2-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-31 are indefinite because it is unclear if the particular compounds embraced by each of the said claims are further limiting the compound of independent claims. The use of the phrase "A compound according to claim.." seems to be directed to a compound that may or may not have all the limitations of the independent claim. Examiner suggests the use of the phrase "The compound of claim ...", which clearly includes all the limitations of the compound described in the independent claim.

Art Unit: 1625

Claim 32 is indefinite and vague. It recites the limitation: "A pharmaceutical composition comprising a compound of claim..."

Applicant's attention is called to the fact that any give composition requires at least two components. Therefore, the said claim lack clarity and is indeed incomplete even though when the said claim has been presented in an open language form. What is the other component of the said pharmaceutical composition? It is a pharmaceutical acceptable carrier?

### **Allowable Subject Matter**

Nonheterocyclic derivatives embraced in the instant claims were not found disclosed or suggested in the prior art. The closest art relevant to the instant invention was found in Spevak et al, WO 2000071506.

Spevak discloses a series of dinaphthyl ureas useful as glucose uptake enhancers. Nonetheless, the said derivatives are quite different to compounds embraced by the instant claims.

### **CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector M Reyes whose telephone number is (571) 272-0691. The examiner can normally be reached on M-F (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary's, Rita Desai can be reached on (571) 272-0684. The fax phone number

Art Unit: 1625

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Héctor M. Reyes PhD JD  
USPTO Reg. # P-54, 846  
Au 1625  
December 1, 2004



Ms. Rita Desai

Primary Examiner

12/2/04